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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial Number: 09/849,315

Atty Docket 4025

Filing Date: May 7, 2001

Art Unit 1772

Inventor: Joseph J. Solon

Examiner Alexander S. Thomas

For: Environmentally Safe Method and Apparatus for Storage of Discarded Tire Rubber

AMENDED BRIEF ON APPEAL



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AMENDED BRIEF ON APPEAL

The Commissioner of Patents and Trademarks

Dear Sir:

Enclosed are three copies of the Amended Brief On Appeal timely filed in response to the Non-Compliance Notice of March 14, 2003.

No fee is required.

Respectfully Submitted, March 27, 2003

Laurence R. Brown, Counsel of Record



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Inventor: Joseph J. Solon

Examiner Alexander S. Thomas

For: Environmentally Safe Method and Apparatus for Storage of Discarded Tire Rubber

AMENDED BRIEF ON APPEAL

To The Commissioner of Patents and Trademarks,

Sir:

Three copies of this Amended brief are presented timely within the one month period following the Notice of Non-Compliance of March 14, 2003. The initial appeal brief was timely filed on January 22, 2003 with the \$160.00 small business appeal brief fee under 1.17(c) within two months of the date of Appeal.

(1) Real party in interest

The real party in interest is the assignee of record –Interstate Recycling Corp. 107 South Street, Auburn, NY 13021.

(2) Related appeals and interferences

None.

(3) Status of claims

At the time of the final rejection, Claims 1-21 and 24 were pending in the application and Claims 18-21 were withdrawn from consideration.

Two amendments were filed after final rejection and two advisory actions were

received respectively on Dec. 17, 2002 and Jan. 8, 2003.

In the latest Advisory Action of Jan. 08, 2003, the Examiner lists Claims 1, 2, 9-11, and 13-15 are rejected; Claims 18-24 withdrawn from consideration and Claims 3-8, 12 and 16 objected to. Also the Examiner indicated that the proposed amendment(s) will be entered for purpose of appeal. Applicant assumed that both amendments filed after final rejection were thus entered and answered to that effect in the brief now objected to. In the current Notice of Non-Compliance the Examiner has clarified, as confirmed by telephone, that applicant's first amendment after final was not entered for purpose of appeal but only the second amendment (which cancelled Claim 17 and amended Claim 11). Accordingly this amended brief addresses the status of claims and related brief sections in that perspective to overcome the notice of non-compliance and provide a correct copy of claims with Claims 3-8, 12 and 16 not rewritten in independent form and claims 14 and withdrawn Claims 18-21 not being cancelled. However it is respectfully noted that in the advisory action of Jan. 8, 2003, the Examiner's listing of claims being withdrawn from consideration should be 18-21, with Claim 24 being rejected under 35 U.S.C. 103(a) as in the first advisory action of Dec. 17, 2002 and the final rejection; since Claims 22 and 23 were cancelled in Applicant's first response of Sept. 20, 2002.

It is to this status that Applicant now responds. Accordingly applicant considers the Claims 18-21 being withdrawn; Claims 3-8, 12 and 16 being objected to as not being put into independent form; and Claims 1, 2, 9-11, 13-15 and 24 being rejected under 35 U.S.C. 103(a).

Thus, Claims 1, 2, 9-11, 13-15 and 24 stand rejected in the final rejection of Oct. 30, 2002 under 35 U.S.C. 103(a) as being unpatentable over Miller in view of Pignataro ('083).

The first 35 U.S.C. 103(a) rejection of Claims 1, 9, 14 and 24 is made in the final rejection, and thus applicant was given no chance for traversal before the final rejection. Thus, a response of record was made in Applicants first response after Final Rejection filed Dec, 09, 2002 including a Declaration Under 37 CFR 1.132 Traversing the Examiner's Rejection Grounds. In this respect Claims 1, 9, 14 and 24 are considered to be prematurely rejected in the Final Rejection.

(4) Status of amendments

Two responses amending the claims were filed after Final Rejection. The Examiner has refused entry of the first amendment, but entered the second for purpose of appeal as indicated in the latest Advisory Action of Jan. 8, 2003. Thus Claim 17 stands cancelled and Claim 11 amended to its original format. .

In the first response of Applicant to the Final Rejection dated Dec. 09, 2002, which the Examiner has not entered for purpose of appeal, Claims 18-21 were cancelled and Claims 3, 11, 12, 16, and 17 were amended with the objective of putting claims 3, and 4-8 dependent thereupon together with claims 12 and 16 into independent form to overcome the outstanding objection and to remove any issue regarding withdrawal of Claims 18-21.

New drawings were also filed to reduce issues as approved in the Advisory action of Jan. 8, 2003.

The declaration under 37 CFR 1.132 traversing the Examiner's rejection grounds was filed, but was not considered by the Examiner for not being solely directed to issues newly raised by the Examiner in the Final Rejection as indicated in the Advisory Action of Jan. 08, 2003.

Thus the claims remaining in the case are 1-16, 18-21 and 24, with correct copies as now of record being reproduced in the Appendix (9).

(5) Summary of the invention

This invention comprises methods of storing and handling batches of flat rubber tire treads excluding the sidewalls, which are cut from discarded tire carcasses and stacked on pallet platforms in compact rubber-to-rubber interfacing configuration, thus eliminating voids for accumulating water in mosquito breeding sites and providing frictional resistance against relative lateral movement of individual tire treads stacked on the pallet loading platforms during transportation. The bulk storage capacity of reusable tire tread rubber at outdoor storage sites is unexpectedly increased many fold over prior art. This is achieved by covering substantially all of the pallet loading platform with the flat tire tread section stacks. Such loaded pallets are pyramided in self supporting relationship upon each other with fork lift trucks. The flat tread strips in some embodiments are folded over in interlocked layers for even more stability to undergo

transportation upon the pallet platforms without necessitating external binding straps retaining the tire tread strips in bundles on the pallet platforms during transportation as Miller teaches.

This invention has the unexpected advantages over prior art bulk storage methods for reclaimable tire tread rubber of (a) avoiding internal cavities that gather water producing mosquito breeding sites when stored in an outside environment, (b) unexpectedly larger densely packed bulk quantities of tire tread strips excluding sidewalls in compact stacks on pallet bulk storage units, and (c) stable in-place transportation on fork lift trucks withstanding vibration and handling without necessitating external fasteners such as straps to bind stacks of tire treads in bundles as Miller requires. .

The Examiner in his first action of Aug. 29, 2002 concedes that Miller does not disclose (a) removing the sidewalls from the tread, (b) completely filling the pallet, (c) storing the pallets outdoors or (d) storing the pallets side-by-side and upon one another.

6) Issues

(a) There is no objection to putting claims 3-8, 12 and 16 into independent form with the foregoing parent claims and applicant respectfully requests leave to so amend these claims after decision on appeal.

(b) There is no objection to cancellation of Claims 18-21 after decision on appeal and applicant respectfully requests leave to do so after decision on appeal.

(c) The Examiner reversibly errs in finally rejecting retained claims 1, 2, 9-11, 13-15 and 24, under 35 U.S.C. 103(a).

The Examiner reversibly errs in finally rejecting Claims 1, 9, 14 and 24 under 35 U.S.C. 103(a) without giving applicant a chance for traversal before final rejection. .

The Examiner reversibly errs by failing to establish a prima-facie case of obviousness of the claimed invention.

The Examiner reversibly errs in misinterpreting the scope and teachings of the cited references. In this respect the Examiner explicitly errs in his interpretation that the Miller Reference bundles *"form a generally solid form and therefore would inherently prevent the accumulation of water"*, and in failing to give merit to the scope of applicant's claims which go against Miller's requirement for integral sidewall structure by excluding sidewalls.

(d) The Examiner reversibly errs in failing to consider and failing to enter the Declaration under 37CFR 1.132 traversing the Examiner's new rejection grounds stated for the first time in the Final Rejection establishing the issue that Miller's structure is a solid block inherently preventing accumulation of water in the final rejection.

(e) The Examiner reversibly errs in failure to enter applicant's first amendment after appeal submitted to reduce issues on appeal. In this respect applicant requests leave to make corresponding amendments after decision on appeal.

(7) Grouping of claims

Claims 1, 9, 14 and 24 are considered a group of claims initially rejected only under 35 U.S.C. 102(b) and thus for the first time were rejected in the Final Rejection under 35 U.S.C. 103(a) without any prior chance for Applicant to traverse.

Claims 3-8, 12 and 16 are considered a group allowable when put into independent form.

The standing Claims 1, 2, 9-11, 13-15 and 24 rejected under 35 U.S.C. 103(a) do not stand or fall together as a group but are independently considered patentable as different novel interacting combinations of elements.

(8) (iv), (v) Argument

(8)(iv) THE 35 U.S.C. 103(A) REJECTION GROUNDS

I. GENERAL BACKGROUND

A. THE REFERENCES APPLIED UNDER 35 USC 103 (a)

Claims 1, 2, 9-11, 13-15 and 24 are rejected as being unpatentable as obvious under 35 U.S.C. 103(a) over Miller in view of Pignataro (083).

Miller 5,472,750 has as its objective general purpose construction elements formed of integral tire tread 13 and sidewall 20 mats. These mats are flattened, stacked and held together by bands 42 in bundles as shown in Fig. 4. Note that the mats cannot naturally lie flat, since the tire carcasses with the treads and sidewall held and substantially right angles together as vulcanized in manufacture have a residual memory that biases the

sidewall and tread toward their tire carcass shape. Thus the flattened mats need to be stacked tightly upon one another and secured into a bale to form a nearly solid block (Col 4, lines 57–60). Miller misrepresents the Fig. 4 structure by failing to show the different thicknesses of the thicker tire treads and thinner sidewalls. The different thicknesses of the tread and sidewall portions thus inherently inserts void spaces between adjacent mats in the transition areas merging the thicker treads into the thinner sidewalls, which void spaces have the propensity of accumulating water puddles that breed mosquitos when stored in the outside environment contrary to this claimed feature of applicant attained by employing tire treads exclusive of sidewalls. Applicant's tread strips excluding sidewalls have the propensity to lie flat in compact rubber-to-rubber interface which avoids water collecting void cavities. Since each of Miller's flattened mats has a thicker tread portion 13 and a thinner sidewall portion 20 (col. 7, lines 23-26), Fig. 4 cannot be considered a "nearly solid block" and is mis-representative in failing to show that the outer ends of the thinner bundled sidewalls do not achieve the same accumulated thickness as that of the centered thicker tread portions as illustrated in Fig. 4.

Also note in col. 7, lines 50-53 that Miller's bundles (Fig. 4) are further strapped together in larger bundles for palletizing, warehousing and handling with fork lift trucks.

The invention of Miller as expressed in the parent Claim 1 defines a structural element in the form of *a generally rectangular block made up of stacked layers of flat flexible mats -- each said flexible mat is generally rectangular and is formed from an*

entire used tire casing having a series of slits in the sidewalls –with retaining means for holding adjacent layers of the block together to provide structural rigidity.

The Examiner concedes in the first action of Aug 29, 2002 that Miller does not disclose completely filling the pallet, storing the pallets outdoors or storing the pallets side by side and upon one another.

The Miller construction element would be taken out of context and therefore must be considered inoperable if formed from flat tread strips *without sidewalls*, a feature explicitly defined in each of applicant's claims rejected under 35 U.S.C. 103(a).

Pignataro 5,834,083 teaches that two used tire tread strips must be *bonded face-to-face*, (Claim 1) on the non-tread side to form two-ply strips (42 Figs. 10, 14 & 18), which are bolted together in groups to form construction components (col 2, lines 24-34).

There is no concept taught here of storing flat tread strips on pallets, nor of piling tread strips singly in compact rubber-to-rubber interfacing configurations with frictional resistance between the tread strips impeding lateral movement of individual tire tread sections relevant to each other while transported on a pallet platform as taught and claimed by applicant. Note conversely that the piles of strips in Pignataro are bolted together in the stacks to form construction elements, and has no objective of storage of bulk rubber for later reclamation as claimed by applicant.

There is no teaching in this reference of any manner of modification of Miller's configurations to remove Miller's sidewalls or to make bundles of mat layers not bonded

together by straps for transportation on pallets. That is taught only by reference to applicant's disclosure, and therefore is not evidence of obviousness under 35 U.S.C. 103(a).

B. STATUS OF APPLICABLE 35 U.S.C. 103 CASE LAW

The Examiner's burden of proof.

In proceedings before the Patent and Office, the examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. *In re Piasecki*, 45 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). The examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art *would lead* that individual to combine the relevant teachings of the references. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Indeed the teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 723 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).----Ex Parte Obukowicz, 27 USPQ2d 1063, 1065 (PTO BA).

See also *In re Oetiker*, 24 USPQ2d 1443, 1444 for a review of the duty of the Examiner to establish a *prima facie* case of obviousness.

The Examiner herein has failed to establish a *prima facie* case by not pointing out how Pignataro leads one of ordinary skill in the art to combine the relevant teachings of the references for each of the separate combinations of Claims 1, 2, 9-11, 13-15 and 24 or the incentive of Pignataro to do so, and therefore fails to fulfil his burden of proof. It is clear that the Examiner has not pointed out any teachings for changing the construction product of the references to an outside bulk storage system with flat tire tread sections excluding the sidewalls required by Miller, nor with stacks of treads not secured in back to back pairs of treads bonded together as Pignataro teaches.

It is reversible error by the Examiner to apply one reference to a second in a manner that would render the second reference inoperative.

Since the Examiner applies Pignataro to Miller as an unexplained or pointed out teaching that the integral Miller sidewalls are obviously exchangeable with tire tread strips without sidewalls, that reasoning is not within the scope of the 35 U.S.C. 103(a) obviousness as now set forth:

—if the *teachings* of a prior art reference would lead one skilled in the art to make a modification which would render another prior art device inoperable, then such a modification would generally not be obvious. *See In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). —*In re Kramer*, 18 USPQ2d 1415 (Fed. Cir. 1991).

The entire nature of the construction products sought for and achieved in Miller and Pignataro either taken alone or in combination would be changed and make inoperable the teachings of these references as the Examiner applies these references to applicant's different disclosure and claims. Viewing these references without previous knowledge of applicant's unique disclosure and claims would not lead one to include applicant's unique features as within the scope of the teachings of these references. Thus, the Examiner has not established obviousness.

II. THE MERITS OF THE CLAIMS

A. CLAIMED LIMITATIONS NOT TAUGHT IN THE CITED ART

Claim 1 is parent to the remaining rejected claims 2, 9-11 and 13-15, and thus is reproduced and primarily discussed since the unobviousness of the parent Claim 1 will

establish unobviousness of all the rejected claims dependent thereupon. The novel features of Claim 1 are emphasized in italics, as follows:

Claim 1. The environmentally safe method of storing and handling batches of rubber pieces salvaged from discarded tire carcasses *in a bulk storage configuration obtained at low cost for compact storage of residual bulk rubber at bulk storage sites from which bulk rubber may be reclaimed in due course for preparation of rubber products*, comprising in combination the steps of: cutting reclaimed tire carcasses into sets of substantially *flat storable sections of tire tread strips excluding sidewalls*, preparing pallets with loading platform areas of specified length and width dimensions for retaining a plurality of stacks of said substantially flat sections in a storage configuration, and *stacking a plurality of the storable sections into said stacks in compact rubber-to-rubber interfacing configurations with frictional resistance against movement of the sections lateral to the pallet platform area* thereby to facilitate transportation on said pallets for storing and recalling the pallets from designated storage areas of confined space.

Both references have the objective of preparing construction elements, and not the method of storing bulk rubber more effectively at bulk storage sites for later reclamation, and particularly in outdoor sites where prior art tire storage systems develop mosquito breeding puddles in the prior art. The elimination of mosquito breeding grounds in

outside bulk storage sites for reclaimable tire rubber is a significant breakthrough in the art and this objective of the invention and is not achieved by either cited reference.

The bundling and storage of individual flat tire tread strips excluding sidewalls with the propensity of lying flat for outdoor bulk storage sites is a novel feature. Note the contrast to Miller who must bind into bundles flattened mats because of the necessity to overcome the bias of previous vulcanization of the tire carcasses holding the treads and sidewall substantially at right angles, and therefor binds them together in bundles.

The *compact rubber-to-rubber interfacing configuration* with frictional resistance to avoid lateral displacement is contrary to Miller's binding the mats in bundles for transport. Thus, the flattened and bonded together bundles of the tread-sidewall mats method of Miller is not in any way equivalent to the flat tire tread sections of applicant that have the propensity to lie flat and in the compact rubber-to-rubber interfacing configuration, as applicant claims.

Accordingly the interacting combination of Claim 1 with its novel configurations and outside bulk storage features is unique and different from both references, which emphasizes that the Examiner did not exercise his duty to provide a prima-facie case of obviousness. Hindsight afforded the Examiner only by applicants claimed disclosure for applying references in the discarded tire arts to achieve different objectives and constituting the exclusion of sidewalls led to the rejection of the different claimed combination of applicant is not obviousness under 35 U.S.C. 103(a).

Note in particular that the compact rubber-to-rubber interfacing feature of tire

tread sections not having integral sidewalls provides a system that inherently does not accumulate water puddles in outdoor storage sites, which is discussed in more detail hereinafter.

III. EXPLICIT REJECTIONS OF THE REJECTED CLAIMS

CLAIMS 1 AND 9 were rejected solely under 35 U.S.C. 102(b) in the initial office action. This rejection ground was dropped in the next office action, the final rejection after applicant's amendment of parent Claim 1 to flat tire tread strip sections *exclusive of sidewalls*. These claims now are rejected in a general grouping of claims under 35 U.S.C. 103(a) for the first time in the final rejection, which applicant had not had the opportunity to traverse.

The Examiner concedes that the primary reference Miller does not disclose removing the sidewalls. In his rejection ground he states (sentence in parentheses inserted):

The secondary reference discloses removing the sidewalls from the tread prior to shipping in a recycling process. (See applicant's Fig. 1 conceding that sidewall removal from carcasses is prior art.) It would have been obvious to one of ordinary skill in the art to remove the sidewalls from the tread as taught by the secondary reference in the process of the primary reference if extra processing steps and expense could be tolerated and depending on the desired final article that is to be made. — Applicant also argues that Miller does not disclose the method step of preventing the accumulation of water in the strips. However, Miller clearly discloses stacking the mats to form a generally solid form and therefore would inherently prevent the accumulation of water; —

Note that the interpretation of Miller in the last clause is for the first time asserted in the final rejection.

As hereinbefore set forth, Claim 1 has several novel and material limitations not

found in Miller including the bulk storage feature not found in either reference, and the compact rubber-to-rubber interfacing configurations of flat tread sections exclusive of sidewalls for producing frictional resistance against relative lateral movement of each of the individual tread sections during transport in bulk on filled pallet platforms by a fork lift truck. Miller teaches that if more bundles are to be transported the Miller bundles need to be bound together by further straps, col. 7, lines 50-53. This is a further teaching contrary to applicants bulk storage and transportation of treads without sidewalls on pallet platforms. The Examiner has conceded that Miller does not teach completely filling the pallet, storing the pallets outdoors, or storing the pallets side by side and upon one another. Thus, the Examiner has not exercised his burden of proof in establishing obviousness of Miller in producing the claimed inexpensive compact bulk storage of tire tread rubber at storage sites as defined in Parent Claim 1.

Claim 9. The method of Claim 1 further comprising the step of piling said flat sections into stacks that avoid accumulation of water when stored outside in the environment.

The Examiner for the first time in the final rejection rejects Claim 9 on 35 U.S.C. 103(a) on the basis: "Applicant also argues that Miller does not disclose the method step of preventing accumulation of water in the strips. However, Miller clearly discloses stacking the tire mats to form a generally solid form and therefore would inherently prevent the accumulation of water; see column 4, lines 57-62."

Miller's stacked mats are not what is claimed, but "said flat sections" of parent

Claim 1 which are treads without sidewalls. Thus, the Examiner errs in rejecting only one feature of the claimed combination rather than the combination in entirety including the novel features of Claim 1 hereinbefore discussed.

Furthermore the Examiner errs in interpreting the Miller reference wherein the “generally solid form” is acknowledged by Miller to be a “*nearly* solid block” at col. 4, lines 59-61. The Examiner erroneously concludes that this “nearly solid block” would inherently prevent the accumulation of water, whereas as a matter of fact, the misrepresented Miller Fig. 4 configuration contains a large number of internal cavities caused by the difference in thicknesses of the tread and sidewall portions (not shown in Fig. 4) that create cavities which would accumulate water in mosquito breeding beds if stored in the outside environment.

Accordingly applicant petitions reversal of this rejection ground with allowance of Claims 1 and 9.

Claims 2, 11, 14 and 15

2. The method of Claim 1 further comprising the step of covering substantially all of the pallet loading platform area with said sections.

11. The method of Claim 1 further comprising the steps of transporting loaded pallets to store at a storage site in a compact configuration with pallets side-by-side and stacked on top upon one another.

14. The method defined in Claim 1 further comprising the step of handling and transporting loaded pallets containing the stacked storable sections with a fork lift truck.

15. The method defined in Claim 14 further comprising the step of compactly storing pallets loaded with said flat treaded strips at a selected outdoor storage site.

The Examiner concedes in the initial office action that Miller “does not disclose completely filling the pallet, storing the pallets outdoors or storing the pallets side by side and upon one another” and concludes obviousness without any evidence or reason such as an allegation that Pignataro teaches that these steps would have been obvious.

The Examiner errs by not addressing the combinations defined as a whole including the interacting combination of features in parent Claim 1, but selecting only elements of the overall interacting combination which are concluded to be obvious in spite of concession of novelty.

Thus the Examiner has failed to exercise his duty of burden of proof of a *prima facie* case of obviousness.

Furthermore the Examiner in failing to consider the 37 CFR 1.132 traversal declaration in the first amendment filed after final rejection puts applicant into the position of final rejection of these claims for the first time in the final rejection while the Examiner refuses to consider applicant’s attempt to traverse the rejection ground.

Accordingly applicant petitions reversal and allowance of Claims 2, 11, 14 and 15.

Claims 10 and 13

10. The method of Claim 1 further comprising the steps of cutting annular sidewall sections from said carcasses, stacking pluralities of annular sidewall sections in a plurality of piles upon said pallet platform and retaining the piles in place upon transportation of loaded pallets resisting lateral movement by strapping the piles to the pallet.

13. -- and stacking said flat treaded strips on said pallets in an interlocked self-supporting rubber-to-rubber configuration without supporting bolts or hardware by stacking a multiplicity of said treaded strips in a configuration that is adapted to resist lateral movement of the flat treaded strips during transport of the pallet by a fork lift truck.

Both these Claims 10 and 13 are dependent upon Claim 1, shown heretofore to be allowable. Furthermore, both these claims define features contrary to the Miller disclosure and Pignataro. Miller neither cuts annular sidewall sections from the carcasses or straps the sidewall sections to the pallet. Nor does Miller interlock flat tread strips to resist lateral movement without bolts or hardware.

The Examiner fails to address the interacting features of the entire claims 10 and 13 including Parent Claim 1 which are contrary to the teachings of Miller in a manner that would destroy the identity and mode of operation of Miller. Modifying a reference into an inoperable format is not 35 U.S.C. 103(a) obviousness (see *In re Gordon and Kramer, supra*). The Examiner thus only rejects excerpted elements, and thus fails to establish a *prima facie* case of obviousness of the claims as a whole.

Accordingly applicant petitions reversal and allowance of Claims 10 and 13.

Claim 24. The method of bulk storage in outdoor sites of discarded tire rubber without accumulation of water comprising the steps of: cutting rubber portions of reclaimed tire carcasses in the format substantially constant thickness flat treaded strips excluding sidewalls, and stacking the flat strips on pallets in a plurality of abutting rubber-to-rubber contact stacks of the treaded strips interlocked in a frictional format for withstanding lateral movement when traveling upon a loading platform of a pallet transported by a fork lift truck with the rubber-to-rubber contact configuration precluding accumulation of water between the strips when stored on the pallets in bulk storage at outdoor locations.

Note the claimed constant thickness flat treaded strips excluding sidewalls.

Claim 24 in the initial office action was rejected only under 35 U.S.C. 102(b) and in the final rejection for the first time was rejected under 35 U.S.C. 103(a). In this final rejection the Examiner for the first time applied Miller as a teaching of storage without accumulation of water. This has been addressed hereinbefore and in applicant's traversal in the declaration under 37 CFR 1.132, which the Examiner has not considered, and has refused to enter. Thus, the Examiner has reversibly erred by not giving applicant a chance for traversal of a rejection ground first set forth in the final rejection. Allowance of Claim 24 is thus respectfully petitioned.

The entire method of Claim 24 goes contrary to both cited references. Neither Miller or Pignataro were concerned about bulk outside storage of discarded tire rubber, and neither recognized any capability to store rubber at outdoor sites without the accumulation of water. The Examiner in his first office action conceded that Miller does not disclose storing the pallets outside.

The Examiner in the final rejection has erroneously misinterpreted the Miller structure to inherently disclose the step of preventing the accumulation of water in the strips, as hereinbefore shown.

Claim 24 defines constant thickness strips expressly contrary to Miller's two-thickness mats which inherently creates voids that would accumulate water because of the different thicknesses of the sidewalls and treads. In that respect Miller's Fig. 4 misrepresents the Miller stack structure, which is thus structured contrary to the

assertions of the Examiner.

Therefore the novel method of Claim 24 is patently presented as a unique method of outside bulk storage of tire rubber in a configuration that eliminates mosquito breeding grounds, and thus represents a breakthrough in the art of bulk storage of discarded tire rubber in outdoor sites. Applicant thus petitions reversal of the Examiner and allowance of Claim 24

IV. THE EXAMINER'S DEFICIENCY IN BURDEN OF PROOF AND APPLICATION OF THE MILLER REFERENCE

Reversible error in the ruling of the Examiner that retained claims 1, 2, 9-11, 13-15 and 24 are obvious under 35 U.S.C. 103(a) has been established as a failure of the Examiner to exercise his burden of proof and thus merits allowance of these claims, which is respectfully petitioned.

It has been established that the interaction of the claimed limitations in these rejected combination claims is not found in either Miller or Pignataro taken singly or in combination, nor is there any teaching in Pignataro that Miller could be modified to provide the claimed methods of any one of these rejected claims.

It has been shown that Miller requires that the sidewalls must be attached to the tire treads to be operational to produce the article of manufacture desired by Miller, but that applicant claims *tire tread strips excluding sidewalls in each of the rejected claims* to directly depart from the teachings of Miller.

It has been shown that the disclosed Miller bundles have been misapplied by the Examiner to selected claim elements rather than the interacting combination of elements in the claims as a whole and in inherently preventing the accumulation of water. The latter, as more extensively clarified hereinafter in the following Sec. (8)(v) V, is critical to applicant's unique objective (not in either reference) of removing mosquito breeding puddles in the bulk storage of reclaimed tire carcass rubber in the outside environment.

It has been established that the references do not contemplate the efficient bulk storage of rubber from tire carcasses, but have the unrelated objective of producing building elements from tire carcasses.

It is established by consideration of 35 U.S.C. 103(a) case law that the Examiner has failed to meet his burden of proof and improperly makes the primary Miller reference inoperative by applying Miller as making and stacking tire tread strips without sidewalls obvious.

Accordingly it is petitioned that the Examiner be reversed in the rejection by allowance of Claims 1, 2, 9-11, 13-15 and 24.

(8)(v) OTHER ERRORS OF THE EXAMINER

V. MISINTERPRETATION OF THE MILLER REFERENCE

In the final rejection the Examiner erroneously interprets the Miller reference as follows: *Applicant also argues that Miller does not disclose the method step of preventing the accumulation of water in the strips. However, Miller clearly discloses*

stacking the tire mats to form a generally solid form and therefore would inherently prevent the accumulation of water; see column 4, lines 57-62.

The Examiner's view that Miller discloses a solid body inherently preventing accumulation of water, fails to consider the many internal cavities of Millers bundled mats that have a propensity to accumulate water. In Miller's bundled mats in the transition region between thicker treads and thinner sidewalls cavities are created which would retain water if the bundles were stored in outside storage sites. Thus there is no way that the Miller banded mats could be solid enough to inherently prevent accumulation of water as the Examiner theorizes. Review of Miller's Fig. 4 will indicate that Miller misrepresents the mat bundles shown in Figure 4 wherein the mat layers are not separated into thicker tread central portions and thinner sidewall portions extending therefrom, but rather indicates that the treads and sidewalls have the same thicknesses. The outer ends of the mats are misrepresented in Fig. 4 as having the same thickness as the central tread portions.

As a matter of recognized fact in automobile tire carcasses, tire tread thicknesses are greater than sidewall thicknesses. Tire treads on reclaimed tires typically are $\frac{3}{8}$ to $\frac{1}{2}$ inch in thickness, whereas the sidewall thicknesses are $\frac{1}{4}$ inch or less. Thus Miller's bundle of nine strips would for $\frac{1}{2}$ inch thick treads be four and a half inches at the center tread region. However, at the outer edges of the sidewalls the accumulated thicknesses would be two and a quarter inch thick or less. In each of the transition zones between the treads and outer edge of the sidewalls a cavity is thus created thus in the Fig. 4 bundle

creating at least 96 internal void cavities. Accordingly the Miller configurations could not inherently prevent accumulation of water when stored in an outside environment, as the Examiner alleges. Note that the void cavities lie between each two mat layers on opposite sides of the central tire tread portions. Thus in view of the greater thickness in the vicinity of the centered tire tread portion, and the much thinner ends of the bundled sidewall outer ends, there would be a significant droop downwardly from the centered tread height.

Accordingly the basis for the Examiner's rejection of claims under 35 U.S.C. 103(a) is erroneous as a matter of misapplying Miller as the primary reference which the Examiner requires to sustain his obviousness rejection ground. Thus it is respectfully solicited that the 35 U.S.C.103(a) rejection of the Examiner be overruled and that Claims 1, 2, 9-11, 13-15 and 24 be allowed.

Furthermore, this is the first 35 U.S.C. 103(a) rejection ground of Claims 1, 9, 14 and 24 in the final rejection, and thus applicant had not been given the opportunity to traverse that rejection ground without the serious restrictions following final rejection. The Examiner has nevertheless now refused to consider the 37 CFR 1.132 declaration of applicant, and refused to enter it for purpose of appeal.

Also the Examiner misapplies Miller by selecting separate elements without consideration of interaction of the several elements in the combination claims rejected. In this respect he overlooks and gives no merit to three claimed material differences over Miller interacting in the rejected combination claims as discussed re: Claim 1 *supra*, namely: (a) the inexpensive and compact bulk storage of reclaimable tire carcass rubber,

(b) with employment of flat tire tread strips exclusive of sidewalls, and (c) the rubber to rubber interfacing configuration of the tread strips exclusive of sidewalls in stacks to facilitate transportation on pallet platforms, therefore misapplying the primary Miller reference.

VI. THE EXAMINER'S OBJECTION TO CLAIMS 3-8, 12 & 16

In the Final Rejection of Oct. 30, 2002, the Examiner indicates the claims 3-8, 12 & 16 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening. In applicant's (non entered) Amendment of Dec, 9, 2002 these claims were so amended. However, the Examiner refused to enter this amendment which would have reduced issues on appeal.

Applicant thus respectfully petitions for allowance of these Claims 3-8, 12 and 16 with leave to enter an amendment putting the claims in independent form following the decision on appeal, because the objection is currently maintained by the Examiner.

VII. REFUSAL TO CONSIDER THE 37 CFR 1.132 DECLARATION

35 U.S.C. 1.132 provides that declarations traversing the Examiner's rejections upon a mode or capability of operation attributed to a reference may be received.

The Examiner only in the Final Rejection and for the first time interprets Miller as follows: *Applicant also argues that Miller does not disclose the method step of preventing the accumulation of water in the strips. However, Miller clearly discloses stacking the tire mats to form a generally solid form and therefore would inherently*

prevent the accumulation of water, see col. 4, lines 57-62.

Note that the first 35 U.S.C. 103(a) rejection ground of Claims 9 and 24 more directly claiming the feature of elimination of water accumulation in bulk storage was made in the final rejection, the first rejection ground under 35 U.S.C. 102(b) being withdrawn.

Therefore the responses after the Final Rejection was the first time applicant was able to respond to the 103 obviousness rejection based upon the Examiner's view that the stacked mats of Miller inherently prevents accumulation of water in the strips. The Declaration under 37 CFR 1.132 was submitted to address this issue. The Examiner did not consider that declaration and refused to enter it for purpose of appeal,

Thus the Examiner errs in rejecting the declaration on the basis that it is not directed to issues which were newly raised by the Examiner in the final rejection. Accordingly entry and consideration of the Declaration as evidence of non-obviousness by this Honorable Board is respectfully solicited.

The declaration, which is directed solely to the new issue of inherent prevention of the accumulation of water by Miller sets forth by applicant's employee who worked with the reclaiming of abandoned tire carcasses and producing marketable products therefrom sets forth facts upon which the traversal disagreement with the Examiner's interpretation of Miller is based.

Material to applicant's claims is the compact rubber-to-rubber interfacing configurations. The sketch in the declaration illustrates that this is not the case in Miller

wherein the cavities x appear because of the diverse thicknesses of tire treads and sidewalls at the intersection of the two. Those cavities are voids that have the propensity of accumulating water to introduce mosquito breeding beds.

Accordingly it is petitioned that the Declaration under 37 CFR 1.132 be entered for purpose of appeal and be considered as evidence of reversible error by the Examiner in his interpretation of the Miller reference.

VIII. SUMMARIZATION AND PETITION

Claims 15-21 are withdrawn and constitute no issue. Applicant will cancel them following decision on appeal.

Claims 1, 2, 9-11,13-15 and 24 rejected under 35 U.S.C. 103(a) are presented for allowance upon reversal of the Examiner.

Claims 3-8, 12 and 16 were indicated allowable with amendments putting them in independent form not being entered by the Examiner. In view of the outstanding objection to these claims, allowance of these claims is petitioned with leave to file the amendment to put them into independent form following the decision on appeal.

The hereinbefore set forth traversal of the rejection grounds under 35 U.S.C. 103(a) of Claims 1, 2, 9-11, 13-15 and 24 has shown reversible error in the rejection of each of these claims. Accordingly applicant petitions reversal of the Examiner and allowance of each of these claims.

As a matter of perspective over the cited art applicant has made a significant

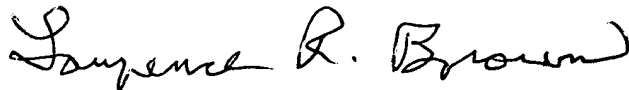
breakthrough in the outside efficiency of storage of reclaimable tire carcass rubber in an manner unexpectedly solving the long existing problem in outdoor tire storage of creating water beds in which mosquitos breed. That breakthrough certainly was not made obvious by Miller or Pignataro either singly or in combination.

Thus allowance of the rejected claims is merited and petitioned.

(9) Appendix

The claims 1-16, 18-21 and 24 currently of record are set forth in the accompanying appendix (9).

Respectfully Submitted, March 27, 2003

A handwritten signature in cursive script, reading "Laurence R. Brown".

Laurence R. Brown, Counsel of Record

Enc.

Appendix (9)

APPENDIX

1. The environmentally safe method of storing and handling batches of rubber pieces salvaged from discarded tire carcasses in a bulk storage configuration obtained at low cost for compact storage of residual bulk rubber at bulk storage sites from which bulk rubber may be reclaimed in due course for preparation of rubber products, comprising in combination the steps of: cutting reclaimed tire carcasses into sets of substantially flat storable sections of tire tread strips excluding sidewalls, preparing pallets with loading platform areas of specified length and width dimensions for retaining a plurality of stacks of said substantially flat sections in a storage configuration, and stacking a plurality of the storable sections into said stacks in compact rubber-to-rubber interfacing configurations with frictional resistance against movement of the sections lateral to the pallet platform area thereby to facilitate transportation on said pallets for storing and recalling the pallets from designated storage areas of confined space.

2. The method of Claim 1 further comprising the step of covering substantially all of the pallet loading platform area with said sections.

3. The method of Claim 1 further comprising the steps of cutting flat rectangular tread strips from the carcasses of a length greater than the length or width dimension of the platform areas and folding the flat tread strips into abutted stacked configurations having a length footprint substantially that of one of the platform dimensions.

4. The method of Claim 3 further comprising the step of abutting said stacked configurations side-by-side to substantially cover the loading platform areas.

5. The method of Claim 3 further comprising the step of interlocking the tread strips in a rubber-to-rubber self-supporting configuration for stable transport of loaded pallets.

6. The method of Claim 5 comprising the more detailed step of disposing two adjacent folded strips of the stacked configuration for frictional contact between the two strips that tends to retard lateral movement of the strips.

7. The method of Claim 6 comprising the more detailed step of contacting one of the two adjacent folded strips in mutual rubber-to-rubber contact over half its length.

8. The method of claim 6 comprising the more detailed step of contacting adjacent folded strips in rubber-to-rubber contact over substantially their entire length.

9. The method of Claim 1 further comprising the step of piling said flat sections into stacks that avoid accumulation of water when stored outside in the environment.

10. The method of Claim 1 further comprising the steps of cutting annular sidewall sections from said carcasses, stacking pluralities of said annular sidewall sections in a plurality of piles upon said pallet platform, and retaining the piles in place upon transportation of loaded pallets resisting lateral movement by strapping the piles to the pallet.

11. The method of Claim 1 further comprising the steps of transporting loaded pallets to store at a storage site in a compact configuration with pallets side-by-side and stacked upon one another.

12. The method of Claim 1 further comprising the steps of cutting the flat storable sections from the carcass tread of a length greater than one pallet dimension to be placed lengthwise along that pallet dimension and folding over said sections to interlock adjacent sections in the stacks by frictional rubber-to-rubber contact between the tread and two adjacent sections.

13. The method of Claim 1 further comprising the steps of:
removing opposing sidewalls from reclaimed tire carcasses to produce a treaded annular portion of the carcasses,

cutting the annular portion to form flat treaded strips of a length and width that may be stacked rubber-to-rubber upon the one of the pallet's dimensions without accumulating water,

configuring said pallets for transport by a fork lift truck, and

stacking said flat treaded strips on said pallets in an interlocked self-supporting rubber-to-rubber configuration without supporting bolts or hardware by stacking a multiplicity of said treaded strips in a configuration that is adapted to resist lateral movement of the flat treaded strips during transport of the pallet by a fork lift truck.

14. The method defined in Claim 1 further comprising the step of handling and transporting loaded pallets containing the stacked storable sections with a fork lift truck.

15. The method defined in Claim 13 further comprising the step of compactly storing pallets loaded with said flat treaded strips at a selected outdoor storage site.

16. The method of Claim 1 further comprising the more detailed steps of: configuring the flat treaded strips longitudinal in shape to have a length compatible with folding and stacking the treaded strips aligned upon one of said length or width dimensions of said pallets in a folded U-shaped configuration with one respective folded strip end trip alternately interlocked between the two ends of an adjacent strip to substantially fill the inner end of the U-shaped configuration, and stacking the interlocked flat treaded strips upon the pallets with the closed end of a plurality of the U-shaped configurations alternating near opposite edges of the pallets.

18. Environmentally safe, low assembly cost apparatus for storing and handling discarded tire carcasses in a configuration for storing outside without the accumulation of water, comprising in combination:

a pallet comprising a loading platform of specified width and length dimensions, and having a configuration for transport by a fork lift truck, and

a plurality of reclaimed treaded tire carcass strips cut from an annular portion of the discarded tire carcasses after removing opposing sidewalls, wherein the annular portion is configured to form flat treaded strips with a length and width for stacking in an interlocked rubber-to-rubber interfacing pattern longitudinally upon said platform along one of the specified dimensions in configuration precluding accumulation of water.

19. The apparatus defined in Claim 18 further comprising a configuration of said plurality of flat treaded strips stacked on said pallet in an interlocked self-supporting configuration that retains a multiplicity of treaded strips in a rubber-to-rubber facing configuration precluding bolts, and cages for frictionally resisting lateral movement on said platform thereby tending to stably remain in place when lifted and transported upon said pallet by a fork lift truck.

20. The apparatus defined in Claim 18 further comprising an accumulation of a multiplicity of the loaded pallets at a storage site in a compactly stored configuration of pallets loaded with said flat treaded strips at an outdoor said storage site.

21. The apparatus defined in Claim 18 further comprising a configuration of a plurality of the flat treaded strips having a length compatible with folding and stacking the treaded strips aligned upon a length or width dimension of said pallet loading platform in a U-shaped configuration with two respective strip ends of one treaded strip alternately interlocked between the ends of adjacent stacked treaded strips stacked upon the pallet substantially filling the closed end of U-shaped configurations with the closed ends alternating at opposite ends of the stacked strips.

24. The method of bulk storage in outdoor sites of discarded tire rubber without accumulation of water comprising the steps of:

cutting rubber portions of reclaimed tire carcasses in the format into flat treaded strips, and

stacking the flat strips on pallets in a plurality of abutting rubber-to-rubber contact stacks of the treaded strips interlocked in a frictional format for withstanding lateral movement when travelling upon a loading platform of a pallet transported by a fork lift truck for bulk storage in outdoor locations.